

## REMARKS

The Examiner objected to claim 1 as being informal. While the Applicants do not agree and instead contend that the claim as written was clear, to advance prosecution and in the belief that the change is not made for reasons of patentability, the claim has been amended.

Claims 1-15 were rejected as being unpatentable in view of Gass in combination with Spychalla. Applicants cannot agree. In essence, the rejection reasons that

It would have been obvious to a person of ordinary skill in the art to provide Gass' table saw with the driving mechanism that drives the cutting tool without being engaged with the mechanism that vertically moves the cutting tool, as taught by Spychalla, in order to reduce the mass of the cutting toll and facilitated vertical movement of the cutting tool. (Page 3)

Curiously, this rationale paraphrases the stated advantage of the presently claimed structure (see e.g., para. [0019] and [0029]). Accordingly, Applicants are left with the distinct impression that the proposed rejection is impermissibly based on a hindsight reading of Applicant's specification. Of course, this is not the proper standard for establishing a *prima facie* case of obviousness. Therefore, the rejection should be withdrawn.

In addition, in combining Gass and Spychalla, the Examiner reasons that "rotating the saw by a direct driving mechanism or an indirect mechanism produce a same end result, since both driving mechanisms are functionally equivalent". Applicants cannot agree. As an initial matter, the Examiner does not provide any objective factual evidence that a direct driving mechanism is functionally equivalent to an indirect driving mechanism (the mere fact that the office action states that they achieve the same result does not, without objective factual evidence does not compel a conclusion that the two

are in fact functional equivalents). The fact that two mechanisms achieve the same result does not mean that each mechanism is the structural equivalent of the other.

Moreover, other than the impermissible hindsight reading of Applicant's specification, there is no identified motivation for selecting bits and pieces from Spychalla and further modifying Gass using those bits and pieces. Indeed, "defining the problem in terms of its solution reveals improper hindsight in the selection of the prior art relevant to obviousness". *Monarch Knitting Mach. Corp. v. Sulzer Morat GmbH*, 139 F.3d 877, 881 (Fed. Cir. 1998). Here, the Office Action defines the problem (weight of the motor and cutting tool) in terms of its solution (a motor configured to indirectly drive the cutting tool) and then looks for any art (Spychalla) that has a cutting tool indirectly driven by a motor. As the Federal Circuit cautions, this is not appropriate. Applicants cannot agree that one of skill in the art possessed with the understanding and knowledge reflected in the prior art, and motivated by the general problem facing Applicants, would have been led to combine Gass and Spychalla. Therefore, Applicants request withdrawal of the rejection.

Moreover, one skilled in the art upon viewing Spychalla would not have been motivated to include the structure taught by Spychalla in the device taught by Gass. Gass teaches pneumatic systems that, upon certain situations, release to withdraw a cutting tool from the cutting region. Indeed, Gass teaches that once activated in response to a dangerous condition, the reaction subsystem is configured to engage operative structure **quickly** to prevent serious injury to the user (see [0027], emphasis added). In contrast, the device of Spychalla requires the user to loosen the nuts 106 on the bolt 105, move the bolt out of the way of the slot 108 on the arm 99 and then lower

the arm, to move the apparatus 101, 102 below the table top. All these steps are the antithesis of the quick action required by Gass. Thus, Spychalla teaches away from the proposed combination.

Even if the proposed combination was tenable, which Applicants strenuously disagree, the proposed combination would not further the objectives of Gass. In fact, if a dangerous condition was detected and the user needed to loosen the nuts, move the bolt, and lower the tip table before the cutting tool was retracted, Applicants submit that the user would already have been injured. In addition, the proposed combination would require the user to lower the blade as taught by Spychalla, while the claim requires the reaction system to effect such action. Thus, the proposed combination does not teach or suggest the presently claimed device.

Applicants also note that the Action states that "[i]t should be noted that the [sic] when the arm 99 is retracted then tension in the belt 100' [sic], 110" is diminished, and consequently the cutting tool will not rotate" (Page 3). Applicants do not find such a teaching in Spychalla and therefore request the Examiner to provide specific support for this assertion.

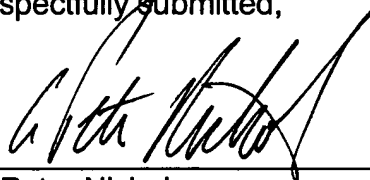
With respect to the rejection of claims 13-15 (pages 4-5), the Action states that Gass teaches a stop 120. Applicants cannot agree. Gass specifically describes the structure 1210 as a locking assembly, which clamps onto the brace member 1208 to prevent further upward movement of the brace member (see para. [0061]). In addition, the pneumatic cylinder 1183 lowers the blade 40 (see para. [0061]). At no time does the locking assembly 1210 contact the pneumatic cylinder 1183, as contended by the Action. Therefore, the rejection is faulty and should be withdrawn.

Claims 1-13 were rejected as being unpatentable in view of Spychalla in combination with Gass. As an initial matter, Applicants note that there is no rationale provided for rejecting claims 13-15 as being unpatentable in view of Spychalla in combination with Gass. Therefore, the rejection must be withdrawn. *See In re Kahn*, 78 USPQ2d 1329, 1336, 441 F.3d 977, \_\_\_\_ (Fed. Cir. 2006) ("rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.").

As for the rejection of the other claims, it is nothing more than the rejection based on Gass in combination with Spychalla and the deficiencies of that rejection have been fully explained above and are incorporated herein. In short, there is no reasonable basis to combine Gass and Spychalla.

It is believed that all the claims are allowable and Applicants request notification to that effect. If, for any reason, the Examiner feels that the above amendments and remarks do not put the claims in condition for allowance, the undersigned attorney can be reached at (312) 321-4276 to resolve any remaining issues.

Respectfully submitted,



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